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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,566	02/27/2002	Keiji Ohbayashi	02126/HG	8962

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,566

Applicant(s)

OHBAYASHI ET AL.

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response filed on 02/03/2004 has been fully considered. The objection to the specification has been withdrawn in view of Applicant's amendment.
2. Claims 1 and 3 are amended; claims 17-32 are canceled, claims 33-35 are added, and thus claims 1-16 and 33-35 are pending.

Claim Rejections - 35 USC § 102

3. Claims 1-5, 7-10, 12, 13, 33 and 34 are rejected under 35 U.S.C. 102(a) as being anticipated by Tsubaki et al. (US 6,335,102 B1).

Tsubaki discloses a support for imaging material comprising a resin coated paper (abstract). Polyethylene is used as the resin to coat the paper, and is coated on both sides of the paper (col. 27, line 45 thru col. 28, line 5). The paper has a water content of 8% by weight (col. 27, line 40). An ink receiving layer is provided on the resin coated paper, wherein the ink receiving layer comprises a binder such as polyvinyl alcohol (col. 25, line 57), and a proper combination of additives such as surfactants, polymer curing agents (equivalent to the claimed hardener), antioxidant (equivalent to the claimed image stabilizer), inorganic particles, and pH adjusters (col. 26, lines 31-62). The process by which the porous layer is formed (see claims 1-5 and 9) is not dispositive of the issue of the patentability of the instant article claims.

4. Claims 1-5, 7, 9, 10, 12-14, 33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohbayashi et al. (US 6,492,005 B1).

The applied reference has a common inventor/assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Ohbayashi discloses an ink jet recording sheet comprising a support and a porous ink absorptive layer (abstract). The ink absorptive layer comprises a hydrophilic binder and inorganic particles (col. 13, line 32). The ink absorptive layer further comprises hardeners, surface active agents, anti-fading agents (equivalent to the claimed image stabilizer), and pH adjusting agents (col. 15, line 26 and col. 16, lines 19-34). The ink absorptive layer further comprises water soluble polyvalent metal compounds (col. 18, line 8). The support is a polyethylene resin coated paper (col. 19, line 43). The process by which the porous layer is formed (see claims 1-5 and 9) is not dispositive of the issue of the patentability of the instant article claims.

5. Claims 1-5, 7, 9, 10, 12, 13, 33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Sismondi et al. (US 6,387,473 B1).

Sismondi discloses ink jet recording sheet comprising a support and at least two ink receiving layers (abstract). The ink receiving layers comprise a hydrophilic polymer (col. 5, line 63), inorganic particles (col. 7, line 11), surfactants (col. 3, line 21),

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hardeners (col. 8, line 62), anti-oxidants and pH adjusting agents (col. 10, lines 37 and 40). The ink receiving layers are coated at the same time (col. 11, line 3). The support is a polyolefin resin coated paper (col. 5, line 5). The process by which the porous layer is formed (see claims 1-5 and 9) is not dispositive of the issue of the patentability of the instant article claims.

Claim Rejections - 35 USC § 103

6. Claims 6, 11, 15, 16 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tusbaki et al. (US 6,335,102 B1), as applied to claims 1-5, 7-10, 12, 13, 33 and 34, above.

With respect to claims 6 and 35, Tusbaki teaches the claimed limitation except for wounding the recording sheet in a roll. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to wound the recording sheet in a roll since it was known in the art that storing a paper in a roll or in stack is commonly practiced.

With respect to claim 11, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust viscosity of coating solutions of a recording medium in order to optimize the coating properties of a layer. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable,

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which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

With respect to claims 15 and 16, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust pH value of coating solution(s) of a recording medium in order to optimize printing qualities after imaging. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

7. Claims 6, 11, 15, 16 and 35 are rejected under 35 U.S.C. 103(a) as being obvious over Ohbayashi et al. (US 6,492,005 B1), as applied to claims 1-5, 7, 9, 10, 12-14, 33 and 34, above.

The applied reference has a common inventor/assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37

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CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

With respect to claims 6 and 35, Ohbayashi teaches the claimed limitation except for winding the recording sheet in a roll. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to wind the recording sheet in a roll since it was known in the art that storing a paper in a roll or in stack is commonly practiced.

With respect to claim 11, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust viscosity of coating solutions of a recording medium in order to optimize the coating properties of a layer. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

With respect to claims 15 and 16, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust pH value of coating solution(s) of a recording medium in order to optimize printing qualities after imaging. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

8. Claims 6, 11, 15, 16 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sismondi et al. (US 6,387,473 B1), as applied to claims 1-5, 7, 9, 10, 12, 13, 33 and 34, above.

With respect to claims 6 and 35, Sismondi teaches the claimed limitation except for wounding the recording sheet in a roll. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to wound the recording sheet in a roll since it was known in the art that storing a paper in a roll or in stack is commonly practiced.

With respect to claim 11, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust viscosity of coating solutions of a recording medium in order to optimize the coating properties of a layer. A prima facie case of

obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

With respect to claims 15 and 16, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust pH value of coating solution(s) of a recording medium in order to optimize printing qualities after imaging. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

Response to Arguments

9. Applicant's argument is based on product-by-process limitation, even though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. Thus, the patentability of the product does not depend on the claimed method of production. If the product in the product-by-process claim is the same as or obvious from the product of the prior art, the claim will be held unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). If the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection will be based alternatively on

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either section 102 or section 103 of the statute. *In re Brown*, 173 USPQ 685, 688 (CCPA 1972). Furthermore, neither the specification nor Applicant's response filed on 02/03/2004 provide factual evidence showing that the product in the product-by-process claim physically different from the product of the prior arts. For the above reasons claims 1-16 stand rejected and claims 33-35 are also included in the rejection.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Betelhem Shewareged
May 13, 2004.